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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/825,823	04/16/2004	Michael K. Ameriks	PRD 2057	9367
27777	7590	10/19/2005	EXAMINER	
PHILIP S. JOHNSON JOHNSON & JOHNSON ONE JOHNSON & JOHNSON PLAZA NEW BRUNSWICK, NJ 08933-7003			GRAZIER, NYEEMAH	
			ART UNIT	PAPER NUMBER
			1626	

DATE MAILED: 10/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/825,823

Applicant(s)

AMERIKS ET AL.

Examiner

Nyeemah Grazier

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-51 is/are pending in the application.
- 4a) Of the above claim(s) 49-51 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☒ Claim(s) 1-48 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>11/8/04, 10/25/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION
FIRST ACTION ON THE MERITS

I. ACTION SUMMARY

Claims 1-51 are currently pending in the instant application and are subject to the required restrictions and elections as described below. Claims 1-48 in part and the whole of claims 49-50 are withdrawn under 37 CFR 1.142(b) as non-elected subject matter.

II. PRIORITY

This application claims the benefit of U.S. Provisional Application Serial No. 60/463,542 filed on April 17, 2003 under 35 U.S.C. 119(e).

III. ELECTION

Response to Election

Examiner has acknowledged Applicant's election of Group I, claims 1-48 with traverse and provisional species election of the compound, "Example 3" found on page 49 of the Specification in the Response to the Restriction Letter filed on August 10, 2005. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim that is remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Applicant's election with traverse of the compound of Group (I) in the reply filed on September 16, 2005 is acknowledged. The traversal is on the ground(s) that (1) Group I and (II) both treat cancer and are both classified in Class 514 and should therefore be examined together;

Art Unit: 1626

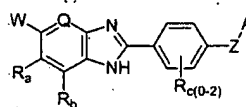
and (2) that Groups (I) through (IV) utilize the compounds of Group (I) and should therefore be examined together.

The grounds for traversal are not persuasive because first, Group (I) and (II) are distinct for the reasons set forth in the restriction letter; namely that the process of treating cancer can be accomplished with products materially different from the instant invention. Thus, the inventions are distinct for the reasons given above and the search required for Group (I) is not required for Group (II), restriction for examination purposes as indicated is therefore proper. Second, the products of Group (III) are classified in class 250 and are distinct invention (labeled compounds). Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper. Additionally the method of studying cancer using ^{11}C -labelled compounds and the method of treating a patient comprising the use of the compounds of formula (I) are distinct inventions and would require separate searches. The requirement is still deemed proper and is therefore made FINAL.

Status of the Claims

Claims 1-48 (in part) are currently pending in the instant application. Claims 1-48 (in part) and 49-51 are withdrawn as said claims are drawn to non-elected subject matter. 37 C.F.R. § 1.142(b).

Applicant elected the compounds of Formula (I)



wherein A is (CO)NH₂, R_a is H, R_b is H, Z is C=O, R_c is 0, Q is CH and A is phenyl.

Art Unit: 1626

Thus, the scope of the invention of the elected subject matter is the compound of Formula (I) wherein:

W is COOH, (CO)NH₂;

Q is CH;

Z is C=O;

A is subgroup (a); and

R_a, **R_b** and **R_c** are as described in Claim 1.

The withdrawn and or cancelled compounds as a result of the restriction various formulas representing divergent and distinct compounds. This recognized chemical diversity of the various formulas can be seen by the various classifications in the US classification system. For example, sulfonyl(piperidine) (where Z is SO₂-piperidinyl) is classified in 546/199. Pyridine imidazoles, for example, are classified in 546/273.4. Benzimidazoles are classified in class 548, subclass 310.7. Thus, the subject matter withdrawn from consideration as being non-elected subject matter differ materially in structure and composition and the fields of search are not co-extensive and therefore have been restricted properly.

The compounds withdrawn by way of restriction are the compounds of Formula (I) wherein **Q** is nitrogen, **W** is (SO₂)NH₂ and **Z** is C=CHR, CR_dR_d, CF₂, CR_dOR_c, C(OR_d)OR_c or subgroups (b), (c), or (d); and wherein **A** is selected from subgroups (b)-(i). Applicant's reservation of the right to file divisional applications on the non-elected subject matter is acknowledged.

The remaining subject matter of claims 1-48 in part and 49-51 that is not drawn to the above invention commensurate with the elected species stands withdrawn under 37 CFR §

Art Unit: 1626

1.142(b) as being for non-elected subject matter. The compounds are not within the elected invention, which are independent and distinct from the elected invention and do not have utility with the elected compound and are therefore withdrawn by way of restriction.

IV. OBJECTIONS

Claim Objection-Non Elected Subject Matter

Claims 1-48 are objected to as containing non-elected subject matter. To overcome this objection, Applicant should rewrite the claims in independent form including all of the limitations of the base claim and any intervening claims and if rewritten directed solely to the subject matter indicated as being examinable.

CONCLUSION

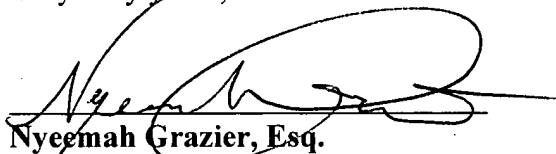
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nyeemah Grazier whose telephone number is (571) 272-8781. The examiner can normally be reached on Monday through Friday from 8:30 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane, can be reached on (571) 272 - 0699. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Art Unit: 1626

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

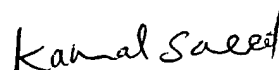
Very truly yours,



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Supervisory Primary Examiner, Art

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